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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,444	07/09/2001	Robert L. Horton	05542/009002	7706

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ROSENTHAL & OSHA L.L.P.
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HOUSTON, TX 77010

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,444

Applicant(s)

HORTON ET AL.

Examiner

Philip C Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12,14-16,18-24 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12,14-16,18-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7, 9-12, 14-16, 18-24 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Quattrini (3660287).

Quattrini teaches a water based fluid which is used to remove deposits from wells, which comprises an ethanol amine and polyethylene glycol (see Examples 1 and 3). Triethanolamine is explicitly taught as being alternatively used instead of the monoethanol amine of the examples, and its use would be instantly envisaged by one of ordinary skill in the art (column 2, lines 48-53). Such would inherently increase the thermal stability of the well fluid.

2. Claims 1-7, 9-10, 12, 14, 15, 18-23 and 26-29 rejected under 35 U.S.C. 102(b) as being anticipated by Hanlon (4524829).

Hanlon teaches a wellbore fluid which comprises a polyacrylamide synthetic polymer and triethanolamine, within the scope of the present invention (see Table I and column 5, lines 33-50). Such triethanolamine would inherently increase the thermal stability of the fluid.

3. Claims 1-4, 9,10, 14, 15, 18, 19, 22, 23, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by RD 249047.

RD 249047 teaches a method of stabilizing a wellbore fluid containing hydroxypropyl guar with triethanolamine, and other amines. Hydroxypropyl guar is a synthetic polymer, since it is made by hydroxypropylation of guar gum. The triethanolamine is at a level of 0.5%, which anticipates the "about 0.6%" of the current claims.


4. Applicant's claim for domestic priority to 60/297,491 is acknowledged. Applicant's amendment distinguishes over Mujis, since Mujis fails to teach the triethanolamine of the present claims. Applicant's arguments with respect to Quattrini have been considered but are not deemed persuasive. Firstly, further review of Quattrini discloses that triethanolamine is taught therein such as to anticipate the present invention. Applicant has argued that Quattrini is silent as to the maintaining of viscosity when subject to higher temperature. Applicant has not shown by experimentation, or given any specific reasons why the amine would increase thermal stability in the current invention but not in the invention of Quattrini. The courts have clearly held that a discovery of an inherent property in an old composition is not a patentable difference (In re Tomlinsin 150 USPQ 623), or that a novel intended use does not impart patentability (In re Pearson 181 USPQ 641). The use of the amine as a thermal stabilizer is thus not a patentable difference over the art of Quattrini, since the

same composition is taught therein, and the same step of mixing the amine with a polymer in a nonoleaginous fluid is disclosed. New rejections are presented herein in view of newly cited prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2958